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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,318	07/19/2001	Jeffery R. Parker	GLOLP0114US	1195

7590

08/13/2003

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EXAMINER

SEMBER, THOMAS M

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/909,318

Applicant(s)

PARKER ET AL.

Examiner

Thomas M Sember

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8,20,21,26,31,32,35-38,40,43,45-56,58,62-64,97-127 and 137-188 is/are pending in the application.
- 4a) Of the above claim(s) 8,20,21,26,31,32,35-38,40,43,45-56,58,62-64,97-127, 154-155 and 156-176 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 137-153 and 156-176 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### **DETAILED ACTION**

Claims 8, 20-21, 26, 31-32, 35-38, 40, 43, 45-56, 58, 62-64, 97-~~123~~-127

withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

Newly submitted claims 154-155 and 177-188 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: applicant admits on page 26 of applicant's response that these newly written claims do not read on the elected species (figures 5-5a).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 154-155 and 177-188 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 137-153 and 156-176 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 290-357 of copending Application No. 09/256,275. Although the conflicting claims are not identical, they are not patentably distinct from each other because the applicant merely uses different terminology to claim the same structure as the structure claimed in 09/256,275.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 137-147 and 157-166 are rejected under 35 U.S.C. 102(b) as being anticipated by Albinger, Jr. Albinger, Jr. discloses a light directing film comprising a thin optically transparent substrate 1 having individual optical elements 10 of well defined shape on or in the substrate to redistribute light passing through the substrate towards a direction normal to the substrate. The optical elements are quite small in relation to the width and length of the substrate. At least some of the optical elements have at least one curved surface (see figure 1-the side surfaces of the optical elements are curved) and at least one planar surface (defined as the flat side surfaces as depicted in figure 1) for redistributing light along two different axes, at least some of the optical elements intersect each other and both surfaces of the optical elements intersect the substrate or another optical element, the optical elements overlap, intersect or interlock each other such that the optical elements substantially cover at least one of the sides of the substrate.

### ***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 171 and 175-176 are rejected under 35 U.S.C. 102(b) as being anticipated by Kojima et al (figure 5). Kojima et al (figure 5) discloses a light directing film comprising a thin optically transparent substrate 2 having individual optical elements of 7 well defined shape on or in the substrate to redistribute light passing through the substrate towards a direction normal to the substrate. The optical elements are quite small in relation to the width and length of the substrate. At least some of the optical elements have at least one two sloping surfaces 7 that intersect each other to form a ridge 71 having ends that intersect the substrate or another optical element where the ridge ends. The ridge of at least some of the optical elements is generally parallel to the length direction of the optical elements. Kojima et al further teaches that the substrate can be used with liquid crystal displays.

***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -  
the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 171 and 175-176 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshikawa et al (figure 6a). Yoshikawa et al (figure 6a) discloses a light directing film comprising a thin optically transparent substrate 1 having individual optical elements of 34 well defined shape on or in the substrate to redistribute light passing through the substrate towards a direction normal to the substrate. The optical elements are quite small in relation to the width and length of the substrate. At least some of the

optical elements 34 have at least one two sloping surfaces that intersect each other to form a ridge having ends that intersect the substrate or another optical element where the ridge ends. The ridge of at least some of the optical elements is generally parallel to the length direction of the optical elements. Yoshikawa et al (figure 4) further teaches that the substrate can be used with liquid crystal displays.

### ***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 171 and 175-176 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishikawa et al (all figures). Ishikawa et al discloses a light directing film comprising a thin optically transparent substrate having individual optical elements of well-defined shape on or in the substrate to redistribute light passing through the substrate towards a direction normal to the substrate. The optical elements are quite small in relation to the width and length of the substrate. At least some of the optical elements have at least one two sloping surfaces that intersect each other to form a ridge having ends that intersect the substrate or another optical element where the ridge ends. The ridge of at least some of the optical elements is generally parallel to the length direction of the optical elements. Yoshikawa et al (figure 4) further teaches that the substrate

can be used with liquid crystal displays. Ishikawa et al further teaches that the substrate can be used with liquid crystal displays.

### ***Allowable Subject Matter***

**If a proper terminal disclaimer were filed to overcome the double patenting rejection the following claims would be allowable:**

Claims 148-153 and 167-170 are allowed.

Claims 156 and 172-174 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments with respect to claims 137-137-153 and 156-176 have been considered but are moot in view of the new ground(s) of rejection.

The arguments with respect to Albinger et al have been fully considered but are not found persuasive. As broadly claimed, Albinger, Jr. discloses a light directing film comprising a thin optically transparent substrate 1 having individual optical elements 10 of well defined shape on or in the substrate to redistribute light passing through the substrate towards a direction normal to the substrate. The optical elements are quite



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small in relation to the width and length of the substrate. At least some of the optical elements have at least one curved surface (see figure 1-the side surfaces of the optical elements are curved) and at least one planar surface (defined as the flat side surfaces as depicted in figure 1) for redistributing light along two different axes, at least some of the optical elements intersect each other and both surfaces of the optical elements intersect the substrate or another optical element, the optical elements overlap, intersect or interlock each other such that the optical elements substantially cover at least one of the sides of the substrate.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Sember whose telephone number is (703) 308-1938. The examiner can normally be reached on Monday - Thursday from 8:00 AM - 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea, can be reached at (703)-305-4939. The fax phone number for this group are (703) 872-9318 for regular communications and (703)-872-9319 for after-final communications.

Any inquiries of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-0956:



Thomas M. Sember

Primary Examiner

8/7/03